

REMARKS

I. Status of Application

Claims 1, 2, 4, 9-11, 17 and 27-37 are all the claims pending in the present Application.

Claims 1, 2, 4, 9-11, 17 and 27-37 have been examined.

II. Claim Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 1, 2, 4, 9-11 and 17 under 35 U.S.C. § 102(e) as allegedly being anticipated by Berger et al. (U.S. Patent No. 6,414,693). Applicant respectfully disagrees.

Initially, Applicant respectfully notes that claim 1 has already been amended to overcome the very argument now being asserted by the Examiner. Specifically, in the Office Action of January 12, 2007, the Examiner has already argued that a user's identity in Berger is “inherently associated” with the user’s order, which the Examiner believed corresponds to “classifying said attached correction data based on an attribute of the user” of previous claim 1.

This limitation was discussed with the Examiner during the Interview of March 13, 2007, at which time the Examiner provided some proposed claim amendments that would overcome such an interpretation. In light of Examiner’s position, and to advance prosecution of the present Application, claim 1 was amended to further clarify the differences between Berger and the present invention.

Applicant now respectfully asserts that Berger does not teach, or even suggest, at least “receiving **an electronic submission associated with a specific user** to which said correction data and additional personal information of the specific user is attached ... **classifying said attached correction data based on the additional personal information of the specific user**”

recited in said received electronic submission and **registering said correction data in said data base based on the classification results,**” as recited in claim 1.

That is, each electronic submission is associated with a specific user, and that specific user provides additional personal information, wherein the system classifies the correction data based on that additional personal information. As such, Applicant submits that the “additional personal information” cannot be interpreted as the “name, or identification, of the user” because **a specific user** is already associated with the correction data, and thus the specific user’s name or identification would not need to be included in the additional personal information provided in the electronic submission.

Applicant respectfully notes that the Examiner has already agreed with this argument, as illustrated in the Office Action of July 5, 2007, where the Examiner attempted to cure the deficient disclosure of Berger by relying on the Goldstein reference (U.S. Patent Publication No. 2001/0032115). Applicant respectfully requests that the Examiner withdraw the present rejection.

Additionally, Applicant notes that in the present Office Action, the Examiner has asserted that although Goldstein teaches the mining operation occurring **after** the data has been registered with the system “claim 1 has not been amended to support Applicant’s argument.” (See Office Action, page 19). The Examiner also asserts that claim 1 “does have the correction data registered with the system first and classify the registered and stored attached correction data later.” (See Office Action, page 19).

Applicant respectfully asserts that no additional amendment is needed, as the claim **already requires for the correction data to be classified before this data is registered and stored.**

Claim 1 recites, *inter alia*, “a received submission processing unit for receiving an electronic submission associated with a specific user ... and registering and storing said correction data in said database.” With respect to the “received submission processing unit,” claim 1 further defines the functions of this unit, stating: “said received submission processing unit classifying said attached correction data based on additional personal information ... and registering said correction data in said data base based on said classification results. In other words, as shown above, the claim limitation highlighted by the Examiner in the Office Action is directed to the same “received submission processing unit.” Furthermore, the claim recites that “registering” the correction data is performed in accordance with the “classification results.” As such, the classification must occur before the data is registered. For this reason, Applicant respectfully asserts that Goldstein does not teach, or even suggest, the above recited limitation.

In light of the arguments presented above, Applicant respectfully asserts that claim 1 patentably distinguishes over the cited art of record. With respect to claims 2, 4 and 10, these claims depend from claim 1. As such, these claims are allowable at least by virtue of their dependency on claim 1. They are also allowable because of additional limitations set forth therein.

Applicant’s independent claim 11 is a method claim and is distinguished over Berger for reasons analogous to those recited for claim 1.

Applicant’s independent claim 17 is an apparatus claim and is distinguished over Berger for reasons analogous to those recited with respect to claim 1.

With respect to independent claim 9, the Examiner now asserts that this claim is unpatentable under 35 U.S.C. § 102(e) as being anticipated by Berger. Applicant respectfully disagrees.

In fact, Applicant notes that the Applicants have already overcome a rejection of claim 9 over Berger alone in the Amendment of April 12, 2007. The Examiner is now relying on the very same reference, which he previously indicated was overcome, to again reject the claims. Specifically, the Examiner now asserts that “a terminal is inherently having the option allowing a user to enter design information without downloading public design data.” (See Office Action, pages 5-6) (emphasis added). This is simply incorrect.

Initially, Applicant notes that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); see also MPEP § 2112 IV. Instead, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); see also MPEP § 2112 IV.

Such is not the case in Berger. Instead, Berger simply allows the user to select a method of downloading public design data, either by picking a style from a menu list, or by entering a previously determined identifying number. There is no disclosure in Berger of an alternative to downloading the public design data. Nor is an alternative method necessarily present, as Berger already includes a method of obtaining correction data. There is simply no disclosure in Berger

that would suggest that “enter[ing] design information without downloading public design data” must necessarily be present.

In fact, when “relying upon the theory of inherency, **the examiner must provide a basis in fact and/or technical reasoning** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990); see also MPEP § 2112 IV. The Examiner has provided no such reasoning. Instead, the Examiner supports this argument by stating that “it is well known that a terminal may allow a user to enter any design information.” This is not proper support.

In fact, it seems that the Examiner is attempting to present an obviousness rejection. That is, the Examiner seems to argue that the above limitation is “well known,” and thus does not have to be supported with any disclosure. This is improper.

Specifically, the standard of teaching required of a prior art reference to support a 35 U.S.C. § 103 rejection is substantially more than to support a 35 U.S.C. § 102 rejection of anticipation, and **the Doctrine of Inherency does not extend beyond anticipation**. Inherency of an advantage and its obviousness are different questions; that which may be inherent is not necessarily known; obviousness cannot be predicated on that which is unknown. *In re Adams*, 53 CCPA 996, 356 F.2d 998, 148 U.S.P.Q. 742 (1966). Inherency and obviousness are entirely different concepts. *In re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143 (CCPA 1976). For at least this additional reason, the Examiner’s position is improper.

As described above, the Examiner has provided no new reference, or any specific teaching within the current art of record, to support his contention that the “it is well known that a terminal may allow a user to enter any design information.” As such, Applicant believes that

the Examiner is taking Official Notice of this fact. If the Examiner is indeed taking Official Notice, **Applicant respectfully asserts that the Official Notice is improper because the Examiner is taking notice of specific knowledge of technical facts.** (See MPEP § 2144.03 (“Assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.”)).

For at least this additional reason, Applicant respectfully requests for the Examiner to withdraw his rejection. However, if the Examiner chooses to maintain the rejection, Applicant respectfully asserts that the Examiner provide support, under MPEP § 2144.03 (C), for the authority on which he or she relies in taking the Official Notice to provide the limitation as claimed.

For at least the reasons asserted above, Applicant respectfully asserts that Berger does not disclose, or even suggest, at least “an information entry selecting means allowing a user to, **enter design information without downloading public design data**, or request transfer of said public design data from the design data publicizing processing unit to the user together with an editing program file,” as recited in claim 9.

III. Claim Rejections Under 35 U.S.C. § 103 **Berger in view of Goldstein**

Claims 27-31 and 35-37 have been rejected by the Examiner under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berger in view of Goldstein (U.S. Patent Publication No. 2001/0032115). Applicant respectfully disagrees.

With respect to claims 27, 28 and 35, these claims depend from independent claim 1. As such, these claims are allowable at least by virtue of their dependency from claim 1. They are also allowable because of the additional features recited therein.

For example, with respect to claim 27, neither Berger, or Goldstein teaches, or even suggests, “[t]he user’s request reflecting design system **as set forth in claim 1**, wherein said additional personal information of the specific user matches categories, **wherein said categories are common to a group of users.**”

More specifically, claim 27 depends from claim 1. Claim 1 requires for the “received submission processing unit” to classify the correction data based on the additional personal information, and then register the correction data “based on the classification results.” Claim 27 further defines the meaning of the claim term “additional personal information.” As such, in claim 27, the received correction data still needs to be classified “based on the additional personal information,” as this information is defined in claim 27, but **before** the data is registered. For this reason, claim 27 is allowable over the cited art of record.

With respect to claims 28 and 35, Applicant respectfully asserts that these claims are also allowable over the cited art of record for reasons analogous to those recited with respect to claim 27.

With respect to claims 29, 30 and 36, these claims depend from independent claim 11. As such, these claims are allowable over the cited art of record at least by virtue of their dependency from claim 11. They are also allowable for reasons analogous to those recited with respect to claim 27 above.

With respect to claims 31 and 37, these claims depend from claim 17. As such, these claims are allowable at least by virtue of their dependency from claim 17. They are also allowable for reasons analogous to those recited with respect to claim 27 above.

Berger

The Examiner has rejected claims 32-34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berger. Applicant respectfully disagrees.

With respect to claims 32-34, these claims depend from independent claims 1, 11 and 17 respectively. As such, these claims are allowable at least by virtue of their respective dependencies.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

This Amendment is being filed via the USPTO Electronic Filing System (EFS).

Applicant herewith petitions the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time if necessary. Any fee due under 37 U.S.C. § 1.17(a) is being paid via the USPTO Electronic Filing System (EFS). The USPTO is also directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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